IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Liles, Terry Wayne et al	§	
Serial No.: 09/845,953	§	Confirmation No.: 3329
Filed: April 30, 2001	§	Group Art Unit: 2192
For: METHOD, COMPUTER PROGRAM PRODUCT, AND SYSTEM FOR INSTALLING AN OPERATING SYSTEM FROM A STORAGE DEVICE USING A SECTOR OFFSET	§	Examiner: Yigdall, Michael J.

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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I. Introduction

The present paper is being filed under the Official Gazette Notice of July 12, 2005 and in response to the Final Office Action mailed March 7, 2007.

A Notice of Appeal with the proper fee is being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for an extension of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. Reasons

In the Final Office Action mailed March 7, 2007, claims 1-3, 6-12, 15-21 and 24-28 were pending. All of the pending claims were rejected under 35 U.S.C. §103 as being unpatentable over Fontanesi et al (U.S. Patent No. 6,681,323) (Fontanesi) in view of van Gilluwe et al (U.S. Patent No. 6,351,850) (van Gilluwe), and in view of Jenevein et al (U.S. Patent No. 6,615,365) (Jenevein).

It is respectfully submitted that the rejection is clearly improper and is without basis. More specifically, as discussed below, there are clear legal deficiencies in the Examiner's position with regard to the rejection of the pending claims under §103.

As the PTO recognizes in MPEP § 2142:

> The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.... The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

As further explained in MPEP §2142:

> To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person.

Accordingly, it is incumbent upon the Examiner in the first instance to factually support a conclusion of obviousness of the claims as a whole.

A. The combination of references fails to teach the claimed subject matter

When evaluating a claim to determine whether it is obvious, all limitations of the claim must be evaluated. However, the combination of Fontanesi, van Gilluwe and Jenevein fails to teach at least the following elements recited in independent claims 1, 10, 19 and 28:

> identifying a sector offset on the storage device such that storage of the image on the storage device at the sector offset will result in the image being stored at or near a highest address of the storage device

and

> determining the sector offset by the control process prior to an operating system being installed on the computer system and prior to the storage device being partitioned (emphasis added).

1. "identifying a sector offset"

The Examiner concedes that Fontanesi fails to teach "identifying a sector offset", for which van Gilluwe is cited. Applicants' specification explicitly defines the term "sector offset" within the context of the application as follows:

> As used herein, the term sector offset defines a physical location on a storage device, such as a storage device 128, without reference to a logical address associated with the storage device. The sector offset is determined by control process 110 prior to an operating system being installed on computer system 120. Accordingly, the sector offset is determined by control process 110 prior to storage device 128 being partitioned into one or more logical drives. In this way,

> the sector offset defines a physical location on storage device 128 without reference to a logical address.

Page 6, lines 12-19 (emphasis added).

In contrast, as described in van Gilluwe at column 2, lines 12-15, the sectors thereof are logical divisions of the hard disk; therefore, the sector numbers correspond to a logical addresses, not physical locations, on the disk. This distinction is not insignificant, as Applicants' claimed "sector offset" enables Applicants' claimed invention to install the operating system image as close as possible to the "end" of the storage device of the target device by identifying a physical location (i.e., a sector offset) at which to install the image so that it is not overwritten during subsequent installation of the operating system that it contains onto the storage device.

Because the cited combination of references fails to teach at least "identifying a sector offset" as required by independent claims 1, 10, 19 and 28, the rejection of those claims, as well as claims 2-3, 6-9, 11-12, 15-18, 20-21 and 24-27, under 35 U.S.C. §103(a) is improper and should be withdrawn.

2. "determining the sector offset...prior to the storage device being partitioned"

The Examiner addressed the emphasized portion of the subject limitation on page 6 of the Office Action and cites, "for example, Fontanesi, column 5, lines 20-24, which shows that an operating system is not yet installed on the computer system, and column 6, lines 42-58, which shows that the characteristics of the storage device are determined prior to partitioning the storage device" as teaching the limitation. The Examiner's analysis of the cited art as applied to the claim limitation is legally deficient in at least the following respect. Specifically, column 5, lines 39-42, of Fontanesi, indicates that FIGS. 3A-3C illustrate "a method for automatically installing an initial software configuration onto a target computer in accordance with an embodiment of the present invention." As noted at column 5, lines 19-20, the "initial software configuration [preferably includes] an operating system...." A thorough reading of the portion of Fontanesi that describes FIGS. 3A-3C (column 5, line 39, through column 8, line 19) reveals that partitioning of the hard disk drive of the target computer (step S180, FIG. 3B) occurs prior to installation of the operating system on the target computer (step S225, FIG. 3C). As implicitly conceded by the Examiner beginning on line 1 of page 4 of the Office Action, Fontanesi does not explicitly teach "identifying a location" at which to store an image file; the Examiner notes only that "Fontanesi cannot store an image file on the storage device...without first identifying a location at which to store the image file." Assuming *arguendo* that the Examiner's assessment of the inherent teachings of Fontanesi in this regard are not incorrect, Fontanesi still fails to

disclose the timing of such a determination; that is, Fontanesi clearly fails to teach or suggest that the determination is made prior to the partitioning of the hard disk drive, as required by the independent claims.

Because the cited combination of references fails to teach at least "determining the sector offset...prior to the storage device being partitioned" as required by independent claims 1, 10, 19 and 28, the rejection of those claims, as well as claims 2-3, 6-9, 11-12, 15-18, 20-21 and 24-27, under 35 U.S.C. §103(a) is improper and should be withdrawn.

B. The combination of references is improper

There is yet another mutually exclusive and compelling reason why the cited references cannot be applied to reject the pending claims under 35 U.S.C. §103.

§2142 of the MPEP also provides:

> [T]he Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.... Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences,' conduct the search and evaluate the 'subject matter as a whole' of the invention.

In the present case, none of the cited references teaches, or even suggests, the desirability of the combination of the teachings therein as specified above and as recited in the independent claims. Thus, it is clear that none of the patents provides any incentive or motivation, either explicitly or implicitly, supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in

either reference or in the state of the art at the time the invention was made for the combination as applied to the independent claims.

Because the cited combination of references fails to teach at least "identifying a sector offset" as required by independent claims 1, 10, 19 and 28, the rejection of those claims, as well as claims 2-3, 6-9, 11-12, 15-18, 20-21 and 24-27, under 35 U.S.C. §103(a) is improper and should be withdrawn.

III. Conclusion

Applicants have therefore demonstrated at least three clear deficiencies in the Examiner's position. Consequently, the rejection is clearly improper and without basis and it is therefore respectfully requested that the rejection be withdrawn.

Respectfully submitted,

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Dated: 5-3-07

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